

REMARKS

The present application was filed on September 26, 2000 with claims 1-27. Claim 28 was added in an Amendment dated June 14, 2004. Claims 1-28 are currently pending in the application. In the outstanding Office Action dated January 3, 2005, the Examiner has: (i) rejected claims 1-3, 6 and 7 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,345,303 to Knauerhase et al. (hereinafter "Knauerhase"), in view of U.S. Patent No. 6,763,460 to Hild et al. (hereinafter "Hild"); (ii) rejected claims 26 and 27 under §103(a) as being unpatentable over U.S. Patent No. 5,504,816 to Hamilton et al. (hereinafter "Hamilton"), in view of Hild; (iii) rejected claims 4, 5, 8, 9 and 23-25 under §103(a) as being unpatentable over Knauerhase in view of Hild, and further in view of Hamilton; (iv) rejected claims 10-13 and 18 under §103(a) as being unpatentable over Knauerhase in view of Hild, and further in view of U.S. Patent No. 6,072,942 to Stockwell et al. (hereinafter "Stockwell"); (v) rejected claims 14-17, 19, 20 and 22 under §103(a) as being unpatentable over Knauerhase in view of Hild and Stockwell, and further in view of Hamilton; and (vi) rejected claim 21 under §103(a) as being unpatentable over Knauerhase in view of Hild and Hamilton, and further in view of Stockwell.

In this response, Applicants traverse the §103(a) rejections for at least the reasons set forth below. Applicants respectfully request reconsideration of the present application in view of the following remarks.

Claims 1-3, 6 and 7 stand rejected under §103(a) as being unpatentable over Knauerhase in view of Hild. With regard to independent claim 1, the Examiner acknowledges that Knauerhase fails to meet the limitation of "transmitting the encrypted data components from the content provider to a transcoding proxy; and transcoding, at the proxy, the encrypted data components; wherein the steps of transcoding and manipulating the encrypted data components are performed without a need for first decrypting the encrypted data components" (Office Action; page 4, paragraph 2). However, the Examiner contends that such limitation is disclosed in Hild, at column 3, lines 19-24 (Office Action; page 4, paragraph 2).

While Applicants respectfully disagree with the Examiner's contention, without characterizing the Hild reference, Applicants submit that Hild is not believed to be prior art against the subject claims. Specifically, Hild, which was filed prior to but issued after the filing date of the

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present application, and the claimed invention were, at the time the invention was made, owned by the same entity or subject to an obligation of assignment to the same entity, namely, International Business Machines Corp. In the present application, this assignment was recorded on September 26, 2000, at reel 011178, frame 0843.

As set forth in 35 U.S.C. §103(c), “[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” Applicants therefore assert that Hild should not be considered prior art in the present application. Accordingly, favorable reconsideration and allowance of claims 1-3, 6 and 7 are respectfully solicited.

Claims 26 and 27 stand rejected under §103(a) as being unpatentable over Hamilton, in view of Hild. With regard to independent claim 26, the Examiner acknowledges that Hamilton fails to disclose the limitation of “wherein the at least one transcoding proxy is operative to selectively manipulate the at least one encrypted component without a need for first decrypting the at least one encrypted component” (Office Action; page 6, paragraph 2). However, the Examiner contends that such limitation is disclosed in Hild. While Applicants respectfully disagree with the Examiner’s characterization of the prior art as used against the subject claims, Applicants submit that Hild, which was owned by the same entity as the claimed invention at the time the invention was made, is not believed to be prior art in the present application, as set forth above. Accordingly, favorable reconsideration and allowance of claims 26 and 27 are respectfully requested.

Claims 4, 5, 8, 9 and 23-25 stand rejected under §103(a) as being unpatentable over Knauerhase in view of Hild, and further in view of Hamilton. Applicants assert that these claims, which depend from claim 1, are also patentable over the prior art by virtue of their dependency from claim 1, which is believed to be patentable for at least the reasons given above. Moreover, one or more of these define patentable subject matter in their own right. While Applicants respectfully disagree with the Examiner’s characterization of the prior art as used against the subject claims, Applicants submit that Hild is not believed to be prior art in the present application, as stated above.

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Accordingly, favorable reconsideration and allowance of claims 4, 5, 8, 9 and 23-25 are respectfully solicited.

Claims 10-13 and 18 stand rejected under §103(a) as being unpatentable over Knauerhase and Hild, in view of Stockwell. Applicants submit that these claims, which depend from claim 1, are also patentable over the prior art by virtue of their dependency from claim 1, which is believed to be patentable for at least the reasons given above. Moreover, one or more of these define patentable subject matter in their own right. While Applicants respectfully disagree with the Examiner's characterization of the prior art as used against the subject claims, Applicants submit that Hild is not believed to be prior art in the present application, as stated above. Accordingly, favorable reconsideration and allowance of claims 10-13 and 18 are respectfully requested.

Claims 14-17, 19, 20 and 22 stand rejected under §103(a) as being unpatentable over Knauerhase, Hild and Stockwell, in view of Hamilton. Applicants submit that these claims, which depend from claim 1, are also patentable over the prior art of record by virtue of their dependency from claim 1, which is believed to be patentable for at least the reasons given above. Moreover, one or more of these define patentable subject matter in their own right. While Applicants respectfully disagree with the Examiner's characterization of the prior art as used against the subject claims, Applicants submit that Hild is not believed to be prior art in the present application, as stated above. Accordingly, favorable reconsideration and allowance of claims 14-17, 19, 20 and 22 are respectfully solicited.

Finally, claim 21 stands rejected under §103(a) as being unpatentable over Knauerhase, Hild and Hamilton, in view of Stockwell. Applicants submit that claim 21, which depends from claim 1, is also patentable over the prior art by virtue of its dependency from claim 1, which is believed to be patentable for at least the reasons given above. Moreover, while Applicants respectfully disagree with the Examiner's characterization of the prior art as used against claim 21, Applicants submit that Hild is not believed to be prior art in the present application, as stated above. Accordingly, favorable reconsideration and allowance of claim 21 are respectfully requested.

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In view of the above, Applicants believe that pending claims 1-28 are in condition for allowance, and respectfully request withdrawal of the §103(a) rejections.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Wayne L. Ellenbogen". The signature is fluid and cursive, with a long horizontal stroke extending from the end.

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